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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/646,904	08/22/2003	Herbert Irschik	103832-510-NP	1332

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EXAMINER	
QAZI, SABIHA NAIM	

ART UNIT	PAPER NUMBER
1612	

MAIL DATE	DELIVERY MODE
09/19/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Advisory Action Before the Filing of an Appeal Brief	Application No.	Applicant(s)	
	10/646,904	IRSCHIK ET AL.	
	Examiner	Art Unit	
	Sabiha Qazi	1612	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 31 July 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

a) ☐ The period for reply expires _____months from the mailing date of the final rejection.

b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
   (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
   (b) ☐ They raise the issue of new matter (see NOTE below);
   (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
   (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5. ☐ Applicant's reply has overcome the following rejection(s): _____.

6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
   The status of the claim(s) is (or will be) as follows:
   Claim(s) allowed: _____.
   Claim(s) objected to: _____.
   Claim(s) rejected: _____.
   Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.

12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____

13. ☐ Other: _____.

/Sabiha Qazi/
Primary Examiner, Art Unit 1612

Continuation of 11. does NOT place the application in condition for allowance because: pplicant's arguments are fully considered but are not found persuasiive. The data in specification does not commensurate with the scope of claims. The specification provides test data for proliferation of three disorazole compounds A1, D1 and E1, since there is no guidance and/or direction provided by the Applicants for method of treatment of oncoses, uncontrolled proliferation, sarcoma, acute lymphatic leukemia (ALL) acute promyleotic leukemia (APL) Hodgkin's disease, lung carcinoma and many more by disorazole compounds of formula I as in claim 1 one skilled in the art would not be able to make and use the invention.Applicants claims: The data in the specification does not commensurate with the scope of the claims.The specification in Table 1 on page 16 discloses the inhibition of proliferation by Disorazole E1, D1 and A1 according to the invention in the XTT cytotoxicity test on human cell lines (proliferation assay, EC50 in □g/ml). Tables 2-4 and comparison with the reference compounds has been fully considered. There is no example to use the compound with another "antitumor agent" or signal transduction inhibitors".

. The specification provides test data for proliferation of three disorazole compounds A1, D1 and E1, since there is no guidance and/or direction provided by the Applicants for method of treatment of oncoses, uncontrolled proliferation, sarcoma, acute lymphatic leukemia (ALL) acute promyleotic leukemia (APL) Hodgkin's disease, lung carcinoma and many more by disorazole compounds of formula I as in claim 1 one skilled in the art would not be able to make and use the invention.

The specification provides test data for proliferation of three disorazole compounds A1, D1 and E1, the claims are too broad and disclosure does not provide guidance or direction for the treatment of all the diseases as claimed. See MPEP 2163.06.

The description requirement of the patent statute requires a description of an invention, not an indication of a result that one might achieve if one made that invention. See, e.g., In re Wilder, 22 USPQ 369, 372-3 (Fed. Cir. 1984). (Holding that a claim was not adequately described because the specification did "little more than outline goals appellants hope the claimed invention achieves and the problems the invention will hopefully ameliorate.")

Mere indistinct terms (such as method claims as presented), however, may not suffice to meet the written description requirement. This is particularly true when a compound is claimed in purely functional terms.

Claims 1-3 and 14 are allowed. Claims 4-5, 9-13 and 18 stant rejected.

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